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First Named Inventor	Engstrom
Art Unit	3629
Examiner Name	Smith, Traci L.
Attorney Docket Number	112076-138339

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Schwabe, Williamson & Wyatt, P.C.		
Signature			
Printed name	Al AuYeung		
Date	July 15, 2005	Reg. No.	35,432

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application for:

Eric G. Engstrom

Application No.: 09/817,837

Filed: March 26, 2001

For: Method and Apparatus For
Generating Electronic Personas

Examiner: Smith, Traci L.

Art Group: 3629

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Appellant's Brief Under 37 C.F.R. §1.192 In Support Of
Appellant's Appeal To The Board Of Patent Appeals And Interferences

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed June 21, 2005, Appellant hereby re-submits the Appeal Brief previously submitted on March 21, 2005 in support of the appeal filed on January 27, 2005. The brief now conforms to 37 CFR 41.37(c). In particular, it contains the proper headings, includes all required appendices, and identifies the status of all claims including amended claims.

The final decision was mailed on October 28, 2004 in response to arguments filed on September 02, 2004. Appellant filed a response to the Final Office Action on December 21, 2004. The Examiner responded with an Advisory Action on January 13,

2005, maintaining the rejections. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

request the device 114, 115 or 116 either generates a personality profile, or causes a second service provider 106 to provide a personality profile, to portray a desired persona based at least in part on a service provided by the content provider 102. Then, the device transmits 114, 115 or 116, or causes the second server 106 to transmit, the personality profile to the first server 102. See e.g. pages 9-10, and Figure 1.

(6) Grounds of Rejection To Be Reviewed On Appeal

- I. Claims 45-68 stand rejected under 35 U.S.C. §102(a) as being anticipated by US Patent 6,285,983 B1 issued to Jenkins.

(7) Argument

- I. Rejection of claims 45-68 under 35 U.S.C. §102 was improper because Jenkins failed to teach each and every limitation of these claims.

The Examiner rejected claims 45-68 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,285,983, to Jenkins ("Jenkins").

It is well settled that anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art to teach each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). Thus, to anticipate the present invention Jenkins must disclose every element recited in the pending claims.

Furthermore, anticipation requires that each claim element must be identical to a corresponding element in the applied reference. *Glaverbel Société Anonyme v. Northlake Mktg & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995).

A. Claims 45 through 63 stand rejected under 35 U.S.C § 102(a)

Claim 45 clearly requires at least:

- a) a receiving operation where a device receives a request from a first server of a first service provider for registration information for a user of the device; and
- b) a generating operation where the device generates or causes another device to generate a personality profile to portray a desired persona based at least in part on a service provided by the first service provider to respond to the request.

In the advisory action dated January 13, 2005, the Examiner first takes notice that it is inherent that information is received by the servers in Jenkins when data collection takes place (see page 2, paragraph 4).

Accordingly, Appellant submits that the core questions to be answered in deciding this issue are:

- a) whether Jenkins' secure server 22 or marketing server 24, practice the equivalent "receiving" operation performed by the required device; and
- b) whether Jenkins' secure server 22 or marketing server 24, practice the equivalent "generating" operation performed by or caused to be performed by the required device.

If either of these questions is answered in the negative, then Jenkins does not anticipate claim 45.

"Receiving" Operation

As noted above and in Appellant's last response, one of Jenkins' servers 22/24 must exhibit all of the attributes and limitations of the device. This includes the "receiving" limitation of the present invention whereby device (A) receives a request for

(1) Real Party in Interest

The real party in interest is Hall Aluminum, LLC, having its primary place of business at 171 Main St. #271, Los Altos, California 94022.

(2) Related Appeals and Interferences

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal, which will directly affect, be directly affected by, or have a bearing on the Board's decision.

(3) Status of the Claims

The Appellant appeals the rejection of claims 45-68.

(4) Status of Amendments

The Examiner noted the entry of an amendment to claim 58 in the Advisory Action dated January 13, 2005. Appellant appeals the rejection of amended claim 58.

(5) Summary of the Claimed Subject Matter

The present invention provides a method and apparatus for generation of electronic personas. In particular, the invention includes, but is not limited to, a device 114, 115 or 116 that receives a request for registration information for a user 117, 118 or 119 of that device 114, 115 or 116 from content provider 102. The registration information includes one or more personality characteristics. In responding to the

registration information of a user of the device (A) from a first server (B) of a first service provider.

In contrast, Jenkins teaches of server 22 accessing data repositories 15 maintained by consumer data collection companies to retrieve consumer data including some element that uniquely identifies consumer 10 (see col. 4, lines 41-51). Server 22 then provides individual records database 50 information to marketing server 24 (see col. 4, lines 61-64). The marketing server 24 receives a request for “abstracted” consumer information, where all of the uniquely identifying information for a consumer has been removed, from a marketer 30 (see col. 5, lines 5-12). While Appellant concedes the Examiner’s position that information is received by the servers in Jenkins, that information does not include a request for registration information of a user of the respective servers. Restated, there simply is no teaching or suggestion in Jenkins that server 22 is receiving a request for registration information of a user of server 22 from marketing server 24, data repository 15, marketer 30 or individual 10. Likewise, there is no teaching or suggestion that marketing server 24 is receiving a request for registration information of a user of marketing server 24 from server 22, data repository 15 or individual 10. Therefore, it follows that since neither of Jenkins’ servers, 22 or 24, are receiving a request for registration information of a user of the respective servers, neither server is performing the “receiving” operation/limitation performed by the claimed device and is thus not identical to the claimed device.

“Generating” Operation

As stated above and discussed in Appellant’s previous response, another attribute or limitation of the device is the “generating” operation. The generating operation requires the device (A) practicing the method to generate or causes another device (C) to generate a personality profile to portray a desired persona based at least in part on the service provided by the first service provider (B). The first service

provider (B) is the same entity that requested user registration information for a user of device (A) as described above in the “receiving” operation. However, Jenkins does not teach or suggest of server 22 or marketing server 24 performing such a “generating” operation.

In contrast, Jenkins teaches that marketers 30 can create marketing profiles on marketing server 24 for querying the classes database 60 in marketing server 24 (see col. 5, lines 22-24). The consumer information contained in the classes database 60 for marketing server 24 is derived from individual records database 50 contained on server 22. The information in the individual records database 50 is acquired from data repositories 15. (see col. 4, lines 53-61).

Regardless of whether or not the individual records represent user registration information, there is no teaching or suggestion that the information in the individual records database 50 represents registration information of a user of server 22. None of the components of system 20 in communication with server 22 are receiving a personality profile to portray a desired persona from server 22 based in part on a service provided by the requesting component. Additionally, there is no teaching or suggestion in Jenkins that server 22 is “causing” server 24 to provide the information to the marketers 30. Therefore, server 22 is not performing the “generating” operation of the claimed device and for this reason is not identical to the claimed device.

Likewise, Jenkins does not teach or suggest that the information contained in the classes database 60 represents registration information of a user of marketing server 24. Moreover, there is no teaching or suggestion that marketing server 24 generates a personality profile to respond to a request for registration information of a user of marketing server 24. Neither is there a teaching or suggestion that marketing server 24 causes another server to generate a personality profile to respond to a request for registration information of a user of marketing server 24. Therefore, marketing server 24

is not performing the “generating” operation/limitation of the claimed device and for this reason is not identical to the claimed device.

Thus, for at least the above reasons, Appellant submits Jenkins cannot be read as having anticipated the above enumerated required elements. Independent claims 52 and 58 contain in substance the same elements as claim 45. Accordingly, for at least the same reasons, claims 45, 52, and 58 are patentable over Jenkins under 102(e).

Claims 46-51, 53-56, and 59-63 depend on claims 45, 52, and 58 respectively, incorporating their limitations. Therefore, for at least the same reasons, claims 46-51, 53-56, and 59-63 are patentable over Jenkins under 102(e).

B. Claims 64 through 68 stand rejected under 35 U.S.C. § 102(a)

Claim 64 requires at least:

an apparatus comprising a storage medium having stored therein a plurality of programming instructions designed to enable the apparatus:

- a) to provide a personality profile for a user of a client device for use to register the user with a service provider, and
- b) the personality profile is based at least in part on a service provided by the service provider.

In the Examiner’s advisory action dated January 13, 2005 regarding claim 64, the Examiner for the first time takes notice that it is inherent if a marketer 30 is retrieving data of a consumer from a commerce site it will be related to that service provided by the e-commerce website. (see page 2, paragraph 7).

Accordingly, Appellant submits that core question to be answered in deciding this issue is:

- a) whether Jenkins’ marketer 30 is equivalent to the required service provider.

Service Provider

To be the required service provider for the embodiment described in claim 64, the marketer 30 must A) register the user; and B) be provided a personality profile based at least in part on the services provided by the marketer 30. For the reasons enumerated in the discussion of the “generating” operation of claim 45, Jenkins does not teach or suggestion the same limitations. In Jenkins, marketers 30 may initiate a search in system 20 according to a marketing profile. Marketing server 24 then provides marketing profiles for each of several marketers 30 (see col. 5, lines 21-31). Marketer 30 may initiate an electronic offer which is passed from server 22 to individual consumers 10 (see col. 5, lines 32-44). The individual consumers 10 responses may be forwarded by secure server 22 to marketer 30 (see col. 5, lines 45-58). Assuming arguendo that “user” is equivalent to “individual consumers 10,” Jenkins does not teach of marketer 30 registering or seeking to register the individual consumers 10. Additionally, a personality profile is not provided/generated to register the individual consumers 10 with marketer 30. Therefore, marketer 30 cannot be the equivalent or identical to the required service provider.

Even assuming that the Examiner intended to equate either server 22 or marketing server 24 with the required service provider, the same analysis applies with the same result. As discussed earlier, Jenkins does not teach or suggest that server 22 or marketing server 24 seek to register users (or the individual consumers 10). Servers 22 and 24 do not provide a service or content for a provided personality profile to be based at least in part on. A personality profile is not provided/generated to register the individual consumers 10 with server 22 or marketing server 24. Therefore, neither server 22 nor marketing server 24 can be the equivalent or identical to the required service provider.

In view of the foregoing, Appellant respectfully submits that, for at least these reasons, Jenkins does not anticipate the required limitations of claim 64. Thus, claim 64 is patentable over Jenkins under 102(e). Claims 65-68 depend on claim 64, incorporating all of its limitations. Thus, for at least the same reasons, claims 65-68 are also patentable over Jenkins under 102(e).

In summary, for reasons the stated above, claims 45-68 are patentable over Jenkins under 35 USC 102(e).

(8) Conclusion


Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

(9) Epilogue

This brief is submitted in triplicate, along with a check for \$500 to cover the appeal brief filing fee. We do not believe any fees, in particular extension of time fees, are needed. However, should that be necessary, please charge our Deposit Account No. 500393. In addition, please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Appellant Applicant

Dated: July 15, 2005



By Al Auyeung
Reg No. 35,432
Schwabe, Williamson & Wyatt, P.C.
Attorney for Appellant Applicant

Appendix A – Claims As Pending

1-44. (Canceled).

45. (Previously presented) A method of operation, performed by a device, comprising:

receiving by the device, from a first server of a first service provider, a request for registration information for a user of the device, the registration information requested including one or more personality characteristics;

generating by the device, or the device causing a second server of a second service provider to provide, a personality profile to portray a desired persona, based at least in part on a service provided by the first service provider, the second service provider providing a personality service; and

transmitting by the device, or the device causing the second server to transmit, the personality profile to the first server to respond to the request.

46. (Previously Presented) The method of claim 45, wherein the method further comprises the device requesting the first service provider for information.

47. (Previously Presented) The method of claim 45, wherein the personality profile is provided by the second server of the personality service provider, based at least in part on a service provided by the first service provider, and transmitted to the first server of the first service provider by the device, and the method further comprises

receiving by the device, the personality profile from the second server of the personality service provider.

48. (Previously Presented) The method of claim 45, wherein the personality profile is provided by the second server of the personality service provider, and the method further comprises

receiving by the device, a list of personality profiles from the second server of the personality service provider, the list having been put together by the second server of the personality service provider, based at least in part on a service provided by the first service provider, and

selecting by the device, a personality profile from the list of personality profiles.

49. (Previously Presented) The method of claim 45, wherein the personality profile is generated by the device, and transmitted to the first server of the first service provider by the device.

50. (Previously Presented) The method of claim 45, wherein the method further comprises requesting by the device, to initiate an e-commerce transaction with the first service provider, or to participate in a chat session hosted by the first service provider.

51. (Previously Presented) The method of claim 45, wherein said one or more personality characteristics comprise at least one selected from a group consisting of a description of hobbies, a description of interests, and a biographical description.

52. (Previously presented) A method of operation, performed by a first server of a first service provider providing a personality service, comprising:

receiving by the first server, from a client device, a request to provide a personality profile for a user of the client device, for responding to a request of a second server of a second service provider, requesting for registration information for the user, the registration information requested including one or more personality characteristics;

providing by the first server, a personality profile for response, based at least in part on a service provided by the second service provider; and

transmitting by the first server to the client device or the second server the generated personality profile to the second server of the second service provider.

53. (Previously Presented) The method of claim 52, wherein said receiving comprises receiving by the first server, the one or more requested personality characteristics from the client device.

54. (Previously Presented) The method of claim 52, wherein the method further comprises the first server ascertaining the service offered by the second service provider, based at least in part on a communication between a server of the second service provider and the first server.

55. (Previously Presented) The method of claim 52, wherein said providing comprises

identifying by the first server, for the client device, a plurality of personality profiles; and

receiving by the first server, from the client device, a selection of one of the identified personality profiles.

56. (Previously Presented) The method of claim 52, wherein said providing comprises generating by the first server one or more personality profiles, based at least in part on a service provided by the second service provider.

57. (Previously Presented) The method of claim 52, wherein said one or more personality characteristics comprise at least one of a description of hobbies, a description of interests, and a biographical description.

58. (Previously Presented) An apparatus comprising:

a storage medium having stored therein a plurality of programming instructions, designed to enable the apparatus to

- receive from a first server of a first service provider, a request for registration information for a user of the apparatus, the registration information requested including one or more personality characteristics,
- generate, or cause a second server of a second service provider to provide, a personality profile, based at least in part on a service offered by the first service provider, the second service provider providing a personality service, and
- transmit, or cause the second server of the personality service provider to transmit, the personality profile to the first server of the first service provider to respond to the request; and

a processor coupled to the storage medium to execute the plurality of programming instructions.

59. (Previously Presented) The apparatus of claim 58, wherein said plurality of instructions are further designed to enable the apparatus to perform at least a selected one from the group consisting of requesting information from the first service provider, initiating an e-commerce transaction with the first service provider, and participating in a chat session hosted by the first service provider.

60. (Previously Presented) The apparatus of claim 58, wherein said plurality of instructions are designed to enable the apparatus to request the personality service provider for the personality profile.

61. (Previously Presented) The apparatus of claim 60, wherein said plurality of instructions are further designed to enable the apparatus to receive a list of personality profiles from the personality service provider, and identify for the personality service provider a selected one of the list of personality profiles.

62. (Previously Presented) The apparatus of claim 58, wherein said plurality of instructions are designed to enable the apparatus to generate the personality profile.

63. (Previously Presented) The apparatus of claim 58, wherein said one or more personality characteristics comprise at least one of a description of hobbies, a description of interests, and a biographical description.

64. (Previously presented) An apparatus comprising:
a storage medium having stored therein a plurality of programming instructions designed to enable the apparatus to provide a personality profile for a user of a client device for use to register the user with a service provider, based at least in part on a service provided by the service provider; and
a processor coupled to the storage medium to execute the programming instructions.

65. (Previously Presented) The apparatus of claim 64, wherein the programming instructions are designed to enable the apparatus to generate the personality profile based at least in part on a service provided by the service provider.

66. (Previously Presented) The apparatus of claim 64, wherein the programming instructions are designed to enable the apparatus to provide a list of personality profiles to the client device, based at least in part a service provided by the service provider, and receive a selection from the provided list from the client device.

67. (Previously Presented) The apparatus of claim 64, wherein said one or more personality characteristics comprise at least one of a description of hobbies, a description of interests, and a biographical description.

68. (Previously Presented) The apparatus of claim 64, wherein said plurality of instructions are further designed to either enable the apparatus to transmit the personality profile to the client device, or transmit the personality profile to a server of the service provider.

Appendix B – Copies of Evidence Submitted

No evidence has been submitted under 37 C.F.R. 1.130, 1.131, or 1.132. No evidence entered by Examiner has been relied upon by Appellants in the appeal.